

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-12, 25-53, and 68-84 are currently pending, and stand rejected under 35 U.S.C. §§ 112. Claims 25 and 68 have been amended to clarify the subject matter recited therein; the amendments are not believed to alter the scope of the claims. Applicants request reconsideration of all pending claims in view of the amendments and remarks herein.

Rejection of Claims 1-12, 25-39, and 68-84 under 35 USC § 112, First Paragraph

Claims 1-12, 25-39, and 68-84 are rejected under 35 USC § 112 as containing subject matter which was not described in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. (Office Action, para. 5.)

Regarding claim 1, the Examiner takes issue with the claim limitation of "parsing the page heading to *produce an index*." (Office Action, para. 5; emphasis in original.) The Examiner states that "[t]he disclosure does not appear to describe a method for producing an index. The disclosure makes reference to an index on page 10 . . . but does not go into detail as to generating or producing an index."

Applicants first note that the examiner bears the burden "of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." MPEP § 2163.04. Here, the examiner has done no more than assert, without explanation as to why the specification would not have been adequate to one of ordinary skill in the art, that five lines of the specification (page 10, lines 12-16) "do not go into detail as to generating or producing an index."

In fact, the disclosure provides more than adequate detail regarding producing the index as recited in claim 1. Here is what the disclosure says:

Once the image files are formed, they allow viewing of an image of every page in the directory as it is to be printed. However, to be useful, the files should preferably be indexed somehow. In particular, for an online directory, it is desirable to provide a page and category (header) index so that a user can access a particular page by its page number or by a category found on that page. Since it is common for categories to span multiple pages, *it is contemplated that each category will be indexed to the first page on which the category occurs*. For an electronic billing system, it is desirable to identify the page on which a particular advertisement appears and the page that will be printed on the opposite side of the same sheet in the printed directory; it is also desirable to highlight the position of the advertisement on the page.

One way to compile the information just described is to provide an interface, called a directory print composition interface, with the system that

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

composed the original EPS representations of the pages. *Such a system typically runs an Oracle DBMS, provided by the Oracle Corporation of Redwood, California, that indexes each advertisement by the spine number of the directory in which the advertisement appears, the advertisement number which identifies the advertisement within the directory, the heading (category) under which the advertisement appears and the page on which the advertisement appears when the directory is composed.* Such information can be used to match each category with the first page on which it appears, which allows a user to type in a name of a category and be taken to the appropriate page. That information, combined with the rectangle definition file, can be used in the electronic billing system to highlight the specific advertisement. The directory print composition interface should be customizable to accommodate EPS files and page/advertisement/category indexing data from any directory publisher. Also, any other source of the needed information can be used, such as a text file of page/heading information or of advertisement rectangle information. (Specification, page 10, line 12 – page 11, line 11; emphases added.)

The specification explains that a category, or header, index allows access to a page by page number or by a category found on the page. This explanation alone is sufficient to have conveyed to one of ordinary skill in the art how the index was produced. Moreover, the specification also explains that the index can be produced by using well known third party software, the Oracle DBMS, and moreover explains how the Oracle DBMS produces the index. The specification further explains that the index can be produced by taking indexing data from any directory publisher. Applicants respectfully submit that the above two paragraphs from the specification are more than adequate to demonstrate possession of the invention recited in claim 1 to one of ordinary skill in the art.

Accordingly, claim 1 is in condition for allowance with respect to Section 112, first paragraph. Claims 2-12 were rejected solely by reason of their dependency on claim 1, and therefore also are in condition for allowance with respect to Section 112, first paragraph.

Similarly, the Examiner takes issue with the limitation in claim 25 of “an index representing an organization of the document.” (Office Action, para. 5.) Referring again to page 10, lines 12-16 of the specification, the Examiner states that “the disclosure does not appear to describe an index representing an organization of the document, but rather is simply described as an integral part of retrieving data.” To the contrary, Applicants respectfully submit that one of ordinary skill in the art would have understood that an index according to a page number or a category was an index representing an organization of a document. Indeed, common sense says that page numbers, for example, are one of the most fundamental ways in which a document is organized.

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

The Examiner further takes issue with the limitation of "a capturing device" recited in claims 25 and 68. The Examiner acknowledges that the specification, at page 11, line 22, discloses "a capturer/electronic directory packager host." Applicants believe that it would have been clear to one of ordinary skill in the art from reading the specification that the "capturing device" recited in claims 25 and 68 comprised the "capturer/electronic directory host" disclosed in the specification. However, Applicants have amended claims 25 and 68 to explicitly recite that the capturing device comprises a "capturer and electronic directory host". Note that Applicants have replaced the "/" character used in the specification with the word "and" only to avoid any question about whether the "/" character makes the phrase "capturer/electronic directory host" indefinite under 35 U.S.C. § 112, second paragraph; it is not intended that any change in meaning be introduced into the phrase.

Accordingly, claim 25 is in condition for allowance. Claims 24-39 were rejected solely by reason of their dependency on claim 1, and therefore also are in condition for allowance. Claims 69-84 were rejected solely by reason of their dependency on claim 68, and therefore also are in condition for allowance.

Rejection of Claims 1-12 and 40-53 under 35 USC § 112, Second Paragraph

Claims 1-12, 20, 40-53, 57-60, and 71-74 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action, para. 7.)

Applicants note that claims 20 and 57-60 have been cancelled, and therefore Applicants presume that the Examiner did not intend to include a rejection of claims 20 and 57-60 in the Office Action, even though paragraph 7 of the Office Action refers to them. Further, claims 71-74 depend from independent claim 68, which the Office Action did not reject under the second paragraph of Section 112, and Applicants therefore assume that the Examiner did not intend to include a rejection of claims 71-74 in the Office Action, even though paragraph 7 of the Office Action refers to them.

The Examiner states that claims 1 and 40 are rejected under 35 U.S.C. § 112, Second Paragraph, because these claims, according to the Examiner, contain a vague limitation: "converting the printing data in the print queue into a plurality of viewable

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

files by capturing the printing data from the print queue and not by producing or scanning hard copies of the print data". (Office Action, para. 7.) The Examiner does not explain how or why the claim language is vague. Rather, the Examiner's reasoning appears to fall under the first, and not the second, paragraph of Section 112 inasmuch as the essence of the Examiner's argument is that the claim language is not supported by the Specification. The Examiner states that:

The disclosure makes reference to "the converter/archiver host 217 converts the EDS files into image files" note page 12. The added limitation is vague and the conversion process does not appear to correspond with page 9 lines 15-20 description of a *converter program* running in the batch mode or page 11-12 *converter/archive host* that converts the data. The disclosure does not appear to state that the conversion takes place in the print queue. (Emphases in original.)

Applicants respectfully submit that the Examiner is misreading the plain language of the claims inasmuch as claims 1 and 40 do not recite conversion taking place *in* a print queue but rather that conversion of printing data that is in a print queue occurs by taking the data *from* the print queue. Specifically, the claims recite that conversion occurs by "capturing the printing data *from* the print queue." Moreover, the claim language is supported by the specification, which discloses that "[e]ach EPS file comes out of the virtual print queue." (Page 9, line 10; *see also* page 11, line 23 – page 12, line 2.) The specification further explains that it is files taken from the print queue (page 9, lines 9-10) that are converted (Page 9, lines 17-19). Accordingly, applicants respectfully submit that claims 1 and 40 are both precise and specifically supported by the specification.

For the forgoing reasons, claims 1 and 40 are in condition for allowance. Claims 2-12 were rejected solely by reason of their dependency on claim 1, and therefore also are in condition for allowance. Claims 41-53 were rejected solely by reason of their dependency on claim 40, and therefore also are in condition for allowance.

Attorney Docket No. 00-VE20.56 (65632-0133)

Serial No. 09/258,123

CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Any fees associated with the filing of this paper should be identified in an accompanying transmittal. However, if any additional fees are required in connection with the filing of this paper, permission is given to charge Deposit Account No. 07-2347.

Respectfully submitted,

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